

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Kelli Hodge Kennedy et al. Examiner: Firmin Backer  
Serial No.: 09/782,765 Group Art Unit: 3621  
Filed: February 13, 2001 Docket No.: 10005680-1  
Title: DOCUMENT DISTRIBUTION SYSTEM AND METHOD WITH  
CONSOLIDATED DOCUMENT SERVICES MANAGEMENT

**DECLARATION OF PRIOR INVENTION UNDER 37 C.F.R. § 1.131**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir/Madam:

This Declaration is submitted to establish prior invention of the subject matter of the present patent application. The persons making this Declaration are the inventors, Kelli Hodge Kennedy, Garth Frederick Schmeling, Darrel David Cherry, and Alexander A. McMains.

Accompanying this Declaration are Exhibits A through I to establish conception of the subject matter of the present patent application prior to the earliest effective date of July 20, 2000 of U.S. Patent Application Pub. No. 2002/0029384 coupled with due diligence from prior to the earliest effective date to the filing date of the present patent application (i.e., constructive reduction to practice).

Exhibit A (3 pages) includes an HP Invention Disclosure submitted by the inventors and stamped as received by the HP Boise Legal Department on June 19, 2000. This invention disclosure was assigned HP Patent Disclosure No. 10005680 and describes subject matter of the present patent application. This invention disclosure identifies that the invention was built or tested with a first public demo on May 31, 2000. In addition, this invention disclosure was witnessed as of June 16, 2000.

Exhibit B (1 page) includes a letter dated August 21, 2000 from HP Patent Attorney-Outsourcing Manager Steven R. Ormiston to Steven E. Dicke of Dicke, Billig & Czaja requesting a quote of the cost to prepare and file a U.S. Patent Application based upon HP Invention Disclosure No. 10005680. This letter was received by Dicke, Billig & Czaja on August 25, 2000.

Exhibit C (1 page) includes a Request for Quote and Engagement Letter Agreement for the preparation and filing of a U.S. Patent Application based on HP Invention Disclosure

**Declaration under 37 C.F.R. § 1.131**

Applicant: Kelli Hodge Kennedy et al.

Serial No.: 09/782,765

Filed: February 13, 2001

Docket No.: 10005680-1

Title: DOCUMENT DISTRIBUTION SYSTEM AND METHOD WITH CONSOLIDATED DOCUMENT SERVICES MANAGEMENT

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No. 10005680. This agreement was signed by Steven E. Dicke of Dicke, Billig & Czaja on September 1, 2000 and by Steven R. Ormiston of HP on September 5, 2000.

Exhibit D (2 pages) includes an invoice dated December 1, 2000 from Dicke, Billig & Czaja to HP for the preparation of the patent application based on HP Invention Disclosure No. 10005680. From this invoice, it can be seen that preparation of the application occurred at least between November 9, 2000 and November 30, 2000. This application was one of a number of unrelated cases which patent attorneys of Dicke, Billig & Czaja worked reasonably hard on during this period and carried out expeditiously.

Exhibit E (2 pages) includes an e-mail dated November 29, 2000 from inventor Kelli Kennedy to patent attorney Scott Lund commenting on the draft patent application for HP Invention Disclosure No. 10005680. This email included the attachment <<flow chart.ppt>>. This attachment describes subject matter of the present patent application.

Exhibit F (1 page) includes an e-mail dated December 1, 2000 from inventor Kelli Kennedy to patent attorney Scott Lund approving of the patent application based on HP Invention Disclosure No. 10005680.

Exhibit G (1 page) includes a letter dated December 1, 2000 from patent attorney Steve Dicke to HP Managing Attorney Steven R. Ormiston. Accompanying this letter was a draft of the patent application prepared for HP Invention Disclosure No. 10005680 as reviewed and approved for filing by the inventors.

Exhibit H (2 pages) includes an e-mail dated January 18, 2001 from patent attorney Steve Dicke to HP Managing Attorney Steven R. Ormiston forwarding a revised draft of the patent application prepared for HP Invention Disclosure No. 10005680. Attached to this e-mail was a letter dated January 17, 2001 from patent attorney Scott Lund to HP Managing Attorney Steven R. Ormiston referencing the revised draft of the patent application based on HP Invention Disclosure No. 10005680.

Exhibit I (1 page) includes a letter dated February 7, 2001 from patent attorney Scott Lund to inventor Kelli Kennedy. This letter was accompanied by a final draft and a Declaration and Power of Attorney document for the patent application based on HP Invention Disclosure No. 10005680. This patent application was subsequently filed on February 13, 2001.

**Declaration under 37 C.F.R. § 1.131**

Applicant: Kelli Hodge Kennedy et al.

Serial No.: 09/782,765

Filed: February 13, 2001

Docket No.: 10005680-1

Title: DOCUMENT DISTRIBUTION SYSTEM AND METHOD WITH CONSOLIDATED DOCUMENT SERVICES MANAGEMENT


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From these exhibits, it can be seen that the subject matter of the present patent application was conceived prior to the earliest effective date of July 20, 2000 of U.S. Patent Application Pub. No. 2002/0029384 coupled with due diligence from prior to the earliest effective date to the filing date of the present patent application (i.e., constructive reduction to practice).

As a person signing below, I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name:   
Kelli Hodge Kennedy

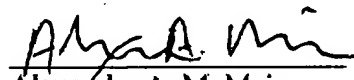
Date: 1/12/2005

Name:   
Garth Frederick Schmeling

Date: Jan 12, 2005

Name:   
Darrel David Cherry

Date: 1/12/2005

Name:   
Alexander A. McMains

Date: 1/12/2005

JAN 18 2005

Write in dark ink on front side only please!

EXHIBIT A



## INVENTION DISCLOSURE

PAGE 1

PONO: 10005680

DATE RCVD

7/26/00

ATTORNEY

RECEIVED

Instructions: The information contained in this document is **COMPANY CONFIDENTIAL** and may not be disclosed to others without prior authorization. Submit this disclosure to the HP Legal Department as soon as possible. No patent protection is possible until a patent application is authorized, prepared, and submitted to the Government.

JUL 19 2000

Descriptive Title of Invention:

Consolidated Document management Process

H.P. BOISE LEGAL

Name of Project:

Tempest

Product Name or Number:

Not yet released

Was a description of the invention published, or are you planning to publish? If so, the date(s) and publication(s):

not published

We will release this to Alpha customers this month (I think)

Was a product including the invention announced, offered for sale, sold, or is such activity proposed? If so, the date(s) and location(s):

not announced, offered for sale, sold. Product is planned for sp'01

Was the invention disclosed to anyone outside of HP, or will such disclosure occur? If so, the date(s) and name(s):

If any of the above situations will occur within 3 months, call your IP attorney or the Legal Department now at 1-898-4919 or 408-898-4919.

Was the invention described in a lab book or other record? If so, please identify (lab book #, etc.):

not in lab notebook.

Was the invention built or tested? If so, the date:

Yes built. First public demo 5/31/00

Was this invention made under a government contract? If so, the agency and contract number:

no government contract

Description of Invention: Please preserve all records of the invention and attach additional pages for the following. Each additional page should be signed and dated by the inventor(s) and witness(es).

- A. Description of the construction and operation of the invention (include appropriate schematic, block, & timing diagrams; drawings; samples; graphs; flowcharts; computer listings; test results; etc.)
- B. Advantages of the invention over what has been done before.
- C. Problems solved by the invention.
- D. Prior solutions and their disadvantages (if available, attach copies of product literature, technical articles, patents, etc.).

Signature of Inventor(s): Pursuant to my (our) employment agreement, I (we) submit this disclosure on this date: [ ]

524649	Kelli Kennedy	<i>Kelli Kennedy</i>	396-3217	804	iIPS Boise Lab
Employee No.	Name	Signature	Telnet	Mailstop	Entity & Lab Name

371704	Garth Schmeling	<i>Garth Schmeling</i>	396-5280	804	iIPS Boise Lab
Employee No.	Name	Signature	Telnet	Mailstop	Entity & Lab Name

352434	Darrel D. Cherry	<i>Darrel D. Cherry</i>	396-5016	804	iIPS Boise Lab
Employee No.	Name	Signature	Telnet	Mailstop	Entity & Lab Name

524637	Alex McMains	<i>Alex McMains</i>	396-4578	804	iIPS Boise Lab
Employee No.	Name	Signature	Telnet	Mailstop	Entity & Lab Name

(If more than four inventors, include additional information on another copy of this form and attach to this document)

Write in dark ink on front side only please?

A

INVENTION DISCLOSURE		COMPANY CONFIDENTIAL	PAGE ____ OF ____
Signature of Witness(es): (Please try to obtain the signature of the person(s) to whom invention was first disclosed.)			
The invention was first explained to, and understood by, me (us) on this date: [ 6/16/200 ]			
Full Name	Signature	Date of Signature	
Bary D Kuntz	Bary D Kuntz	6/16/2000	
Full Name	Signature	Date of Signature	

Inventor & Home Address Information: (If more than four inventors, include addl. information on a copy of this form & attach to this document)			
Inventor's Full Name			
Kelli Hodge Kennedy			
Street			
1405 North 12 <sup>th</sup> Street			
City		State	Zip
Boise		ID	83702
Do you have a Residential P.O. Address? P.O. BOX		City	State Zip
NO			
Greeted as (nickname, middle name, etc.)		Citizenship	
Kelli		USA	

Inventor's Full Name			
Garth Frederick Schmeling			
Street			
4962 N. Fieldcrest Pl			
City		State	Zip
Boise		ID	83704
Do you have a Residential P.O. Address? P.O. BOX		City	State Zip
NO			
Greeted as (nickname, middle name, etc.)		Citizenship	
Garth		USA.	

Inventor's Full Name			
Darrel David Cherry			
Street			
1091 W. Leon St			
City		State	Zip
Meridian		ID	83642
Do you have a Residential P.O. Address? P.O. BOX		City	State Zip
Darrel			
Greeted as (nickname, middle name, etc.)		Citizenship	
		United States	

Inventor's Full Name			
Alexander McMains			
Street			
4650 Northwind Ct.			
City		State	Zip
Boise		ID	83714
Do you have a Residential P.O. Address? P.O. BOX		City	State Zip
Alex			
Greeted as (nickname, middle name, etc.)		Citizenship	
		USA	

Write in dark ink on front side only please?

**Description of Invention:** Please preserve all records of the invention and attach additional pages for the following. Each additional page should be signed and dated by the inventor(s) and witness(es).

A. Description of the construction and operation of the invention (include appropriate schematic, block, & timing diagrams; drawings; samples; graphs; flowcharts; computer listings; test results; etc.)

Provide a document management appliance that provides these key functions: upload documents to appliance using a standard format (PDF); store documents for further processing; allow clients to 1) preview document, 2) print document to a local printer 3) attach document to an email message and send to recipient 4) send document to an internet print provider service. Additionally the document management appliance provides dynamic discovery of new document services (like additional print providers) using the e-speak service locator.

B. Advantages of the invention over what has been done before.

The document management appliance provides a central document management platform for deploying document management services. The advantage is that these services do not have to be deployed on each client machine. An additional advantage is that new services are discovered and deployed centrally and made available to all clients. These advantages are not available in any other known solution.

C. Problems solved by the invention.

The problems solved by this invention are central deployment of document management services, automatic discovery and deployment of new services, managed access to document management services for user privileges to services, and central administration of services.

D. Prior solutions and their disadvantages (if available, attach copies of product literature, technical articles, patents, etc.).

Prior solutions require that document management services be deployed on each client, and that new services be deployed/discovered manually to each client, and that each service be managed on each client.

Hewlett-Packard Company  
LEGAL DEPARTMENT  
11307 Chinden Boulevard  
Boise, Idaho 83714  
(208) 396-4038



EXHIBIT B

August 21, 2000

Steven E. Dicke, Esq.  
DICKE, BILLIG & CZAJA, PA  
Suite 1250, 701 Building  
710 Fourth Ave South  
Minneapolis, MN 55415



Re: Preparation *and filing* of Patent Applications for the attached invention Disclosures

\* File Directly to USPTO by: *November 18, 2000* - 10005680-1

File Directly to USPTO by: *February 18, 2001* - [REDACTED]

Dear Steven:

We would like you to provide us with a quote of the cost for your firm to prepare *and file* (direct with the USPTO) a US patent application based on the HP invention disclosure(s) identified above, copies of which are enclosed. Your quote should be based on preparing and filing the application as specified on the attached green checklist.

You must use HP's USPTO forms and only reference HP's docket number on all filing documents and correspondence with the USPTO. All filing fees should be charged to HP's deposit account noted on the HP forms. Please do not prepare or file an assignment, HP will do that. Any questions regarding HP's forms and the JetForm software for use with HP's forms should be directed to Jennifer Torres at (650) 857-5796.

Your quote should be submitted on the enclosed Request for Quote And Engagement Letter Agreement. If your quote is accepted, we will return a fully executed copy of the Agreement to you for your records. The Agreement will not be binding on you or on HP until signed by HP's authorized representative. If the Agreement is not signed and returned to HP, any bills submitted by you cannot be paid.

Thank you for your assistance in this matter. If your review indicates a possible conflict for your firm, you should advise us within one week of receipt of this letter.

Sincerely,

Steven R. Ormiston  
Patent Attorney-Outsourcing Manager

SRO/bh

Enc: *Invention Disclosure*  
*Request for Quote/Agreement; Checklist*

**Request for Quote and Engagement Letter Agreement****EXHIBIT C**

RE: Hewlett-Packard Docket No. 10005680-1

USSN:

- ☒ This is a request for a quote for the following services:  
☐ This is a confirmation of your quote for the following services:

**PREPARE**☒ Application☐ Response☐ Other \_\_\_\_\_☒ File with USPTO☐ Return to HP for filing☒ YOUR FINISHED PRODUCT TO HP SHOULD INCLUDE ALL ITEMS ON THE ENCLOSED CHECKLIST.**HP REQUIRED DATES:**Nov. 18, 2000

Date for Receipt by HP

Date to be Filed in PTO

**HP Attorneys of Record: (to be included on the Declaration)**

Customer Number

**022879****HP Primary Technical Contact:**

Kelli Kennedy

Telephone No.: (208) 396-3217

FAX No.:

HP Entity: iIPS.BOI

Address: 11307 Chinden Blvd.  
Boise, ID 83714**ADDITIONAL TERMS OR INSTRUCTIONS:**

\*\*\*On the DEC and POA, please list LANE R. SIMMONS as the designate person the USPTO will contact regarding this application\*\*\*

TOTAL PRICE: 

(including Formal drawings)

I agree to the terms of this Agreement including the additional terms above, pursuant to the HP Procedures for Outside Counsel revised **OCTOBER 15, 1999** a copy of which I have received and reviewed. This Agreement will not be binding on either party until signed by an authorized representative of HP.

DICKE, BILLIG &amp; CZAJA, PA

HEWLETT-PACKARD COMPANY

By: Steven E. Dicke

Steven E. Dicke

By: Steven R. Ormiston

Steven R. Ormiston

Dated: 9/1/00Dated: 9/5/00



# DICK, BILLIG & CZAJA, P.A. 39503490

Patent • Trademark • Copyright  
ATTORNEYS

Suite 1250 • 701 Building • 701 Fourth Avenue South • Minneapolis, Minnesota 55415  
Telephone: (612) 573-2000 Facsimile: (612) 573-2005

RECEIVED

DEC 18 2000

H. P. BOISE LEGAL

DEC 12 2000

Hewlett-Packard Company  
Financial Administrator  
Legal Department, Finance Section  
P.O. Box 10301  
Palo Alto CA 94303-0890  
U.S.A.

HP LEGAL FINANCE

Page: 1  
12/01/00  
Account No: 302-144101M  
Statement No: 6934

EXHIBIT D

Attn: Steve Ormiston

CONSOLIDATED DOCUMENT MANAGEMENT PROCESSES  
Steven R. Ormiston, Esq.  
HP Docket No.: 10005680-1

*Nicki*

*SRO/LRS*

## Fees

11/09/00 preparing for and in inventor conference  
11/24/00 drafting claims and preparing specification  
for patent application  
11/25/00 preparing drawings and specification for  
patent application  
11/26/00 preparing specification for patent  
application  
11/27/00 preparing specification for patent  
application  
11/28/00 preparing specification for patent  
application  
11/30/00 discussing patent application with inventor  
Kelli Kennedy; editing patent application  
Paralegal time in review of application;  
obtaining inventor signatures; preparation of  
patent application and filing papers at U.S.  
patent office.  
Paralegal time in preparation of IDS

For Current Services Rendered

## Expenses

10/25/00 Long Distance Phone Charges  
10/31/00 Photocopy Charges  
11/30/00 Postage (First class mail, Express Mail, Federal  
Express, etc.)

Total Expenses

## Advances

11/28/00 ILLUSTRATING FEES - FORMAL PATENT DRAWINGS

Hewlett-Packard Company

Page: 2

12/01/00

Account No: 302-144101M

Statement No: 6934

CONSOLIDATED DOCUMENT MANAGEMENT PROCESSES

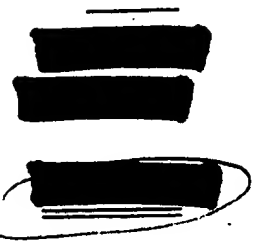
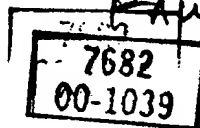
Steven R. Ormiston, Esq.

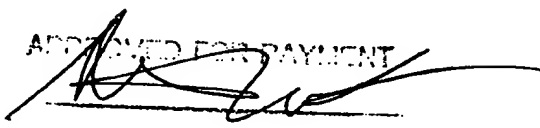
HP Docket No.: 10005680-1

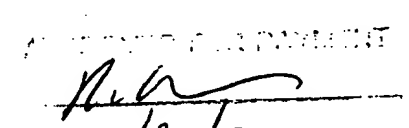
Total Advances

Total Current Work

Balance Due



APPROVED FOR PAYMENT  
  
\_\_\_\_\_

APPROVED FOR PAYMENT  
  
1/29/01  
\_\_\_\_\_

166878

**\*\*TERMS: NET 30 DAYS FROM DATE OF INVOICE**

Payments received after the first of the month will reflect on next month's statement. For questions regarding your account, please call Tammy at (612) 573-0079.

**Scott Lund - patent draft with comments**

---

**From:** "KENNEDY,KELLI (HP-Boise,ex1)" [REDACTED]  
**To:** "Scott Lund (E-mail)" [REDACTED]  
**Date:** 11/29/2000 5:27 PM  
**Subject:** patent draft with comments

---

Scott,

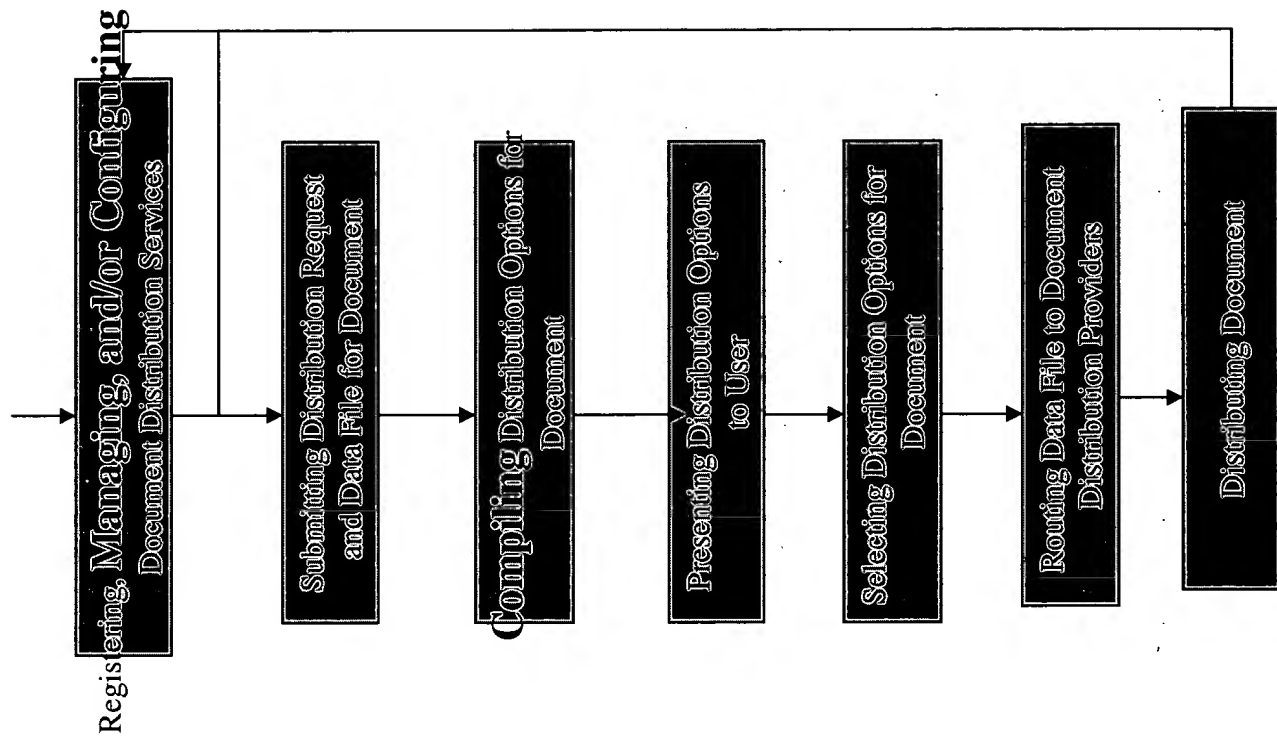
Attached is the Word doc you sent with our comments highlighted. (there are only a few....excellent job!). One part that I did find confusing is the flow chart (figure 6). I attached a flow chart that I threw together that illustrates the issues I had with it. My understanding of a flow chart is that there are not any objects, only events/choices. For this reason, I took out the User and Document Distribution Providers objects. Feel free to ignore the diagram if you deem that is best....since we come from such domains, our notions of a flow chart could be very different.

After reading the draft, I did not come away feeling that I had been "hit in the face" by what was really cool about the invention. To me, the coolest part is that it consolidates the management of all of these doc-distribution services. These services are managed centrally, not on each and every client PC. New services can be added to the system without changing the configuration of any clients. This is very powerful.

One other thing I wanted to ask is whether there should be some mention of the fact that the Document Distribution Controller will transmit user's instructions to the Document Distribution Services? For example, if the user wanted 8 copies, printed on both sides, and in color, these preferences would be transferred to the Document Distribution Services, so that their output would be as they desired.

Talk to you tomorrow,  
Kelli

<<flow chart.ppt>> <<patent draft 1.doc>>



**Scott Lund - sounds good**

---

**From:** "KENNEDY,KELLI (HP-Boise,ex1)" [REDACTED]

**To:** "Scott Lund (E-mail)" [REDACTED]

**Date:** 12/1/2000 4:13 PM

**Subject:** sounds good

---

I got your voice mail and I am satisfied that we should call it good, and my co-inventors agree. Go ahead and leave in the part about the sysAdmin being computer hardware.

Thanks,  
Kelli

# DICKE, BILLIG & CZAJA, P.A.

Patent • Trademark • Copyright  
ATTORNEYS

Suite 1250 • 701 Building • 701 Fourth Avenue South • Minneapolis, Minnesota 55415  
Telephone: (612) 573-2000 Facsimile: (612) 573-2005

Steven E. Dicke  
Direct Dial: (612) 573-2002

December 1, 2000

Steven R. Ormiston, Esq.  
HEWLETT-PACKARD COMPANY  
Legal Department  
11307 Chinden Boulevard, M/S 314  
Building #7  
Boise, ID 83714

*via Federal Express*

RE: U.S. Patent Application  
DOCUMENT DISTRIBUTION SYSTEM AND METHOD WITH  
CONSOLIDATED DOCUMENT SERVICES MANAGEMENT  
HP File No.: 10005680-1  
DBC File No.: H302.144.101

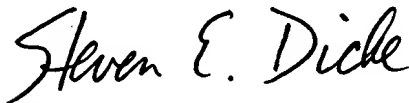
Dear Steve:

Enclosed for your review is the above-identified patent application. This application has been approved by the inventor(s). After I hear from you, I will proceed with obtaining the inventor's signature(s) and filing this application with the USPTO.

If you have any questions regarding this matter, please contact me at (612) 573-2002.

Regards,

DICKE, BILLIG & CZAJA, P.A.



Steven E. Dicke

SED:SAL:ljj

Enclosure

**From:** Steve Dicke  
**To:** Ormiston@idahopatents.com  
**Date:** 01/18/2001 2:01 PM  
**Subject:** HP 10005680-1

---

Steve-

See attachments.

Regards,

Steven E Dicke

DICKE, BILLIG & CZAJA, P.A.  
701 Fourth Ave. South, Suite 1250  
Minneapolis, MN 55415  
Tel: 612.573.2002  
Fax: 612.573.2005  
Email: [sdicke@dbclaw.com](mailto:sdicke@dbclaw.com)

This electronic mail transmission may contain confidential or privileged information. If you believe that you have received the message in error, please notify the sender by reply transmission and delete the message without copying or disclosing it.

# DICKE, BILLIG & CZAJA, P.A.

Patent • Trademark • Copyright  
ATTORNEYS

Suite 1250 • 701 Building • 701 Fourth Avenue South • Minneapolis, Minnesota 55415  
Telephone: (612) 573-2000 Facsimile: (612) 573-2005

Scott A. Lund  
Direct Dial: (612) 573-2006

January 17, 2001

Steven R. Ormiston, Esq.  
HEWLETT-PACKARD COMPANY  
Legal Department  
11307 Chinden Boulevard, M/S 314  
Building #7  
Boise, ID 83714

*via Federal Express*  
EMAIL *cm*

RE: REVISED U.S. Patent Application  
DOCUMENT DISTRIBUTION SYSTEM AND METHOD WITH  
CONSOLIDATED DOCUMENT SERVICES MANAGEMENT  
HP File No.: 10005680-1  
DBC File No.: H302.144.101

Dear Steve:

Enclosed for your review is a REVISED DRAFT of the above-identified patent application. After I hear from you, I will proceed with obtaining the inventor's signature(s) and filing this application with the USPTO.

If you have any questions regarding this matter, please contact me at (612) 573-2006.

Regards,

DICKE, BILLIG & CZAJA, P.A.

  
Scott A. Lund

SAL:lj

Enclosure



# DICKE, BILLIG & CZAJA, P.A.

EXHIBIT I

Patent • Trademark • Copyright  
ATTORNEYS

Suite 1250 • 701 Building • 701 Fourth Avenue South • Minneapolis, Minnesota 55415  
Telephone: (612) 573-2000 Facsimile: (612) 573-2005

Scott A. Lund  
Direct Dial: (612) 573-2006

February 7, 2001

Kelli Kennedy  
HEWLETT PACKARD COMPANY  
11311 Chinden Blvd.  
M/S 804  
Boise, ID 83714

Re: New U.S. Patent Application for:  
**DOCUMENT DISTRIBUTION SYSTEM AND METHOD WITH  
CONSOLIDATED DOCUMENT SERVICES MANAGEMENT**  
H-P File No.: 10005680-1  
DBC File No.: 302.144.101

Dear Kelli:

Please find enclosed a clean copy of a FINAL DRAFT of the above-identified patent application and a marked-up copy of the FINAL DRAFT (with changes "tracked"). In addition, please find enclosed a DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION document. The Declaration and Power of Attorney document needs to be executed by you and the other inventors for filing with the U.S. Patent and Trademark Office.

Please see that each inventor signs and dates the Declaration and Power of Attorney document where indicated. Due to the timeliness of this matter, please return the signed Declaration and Power of Attorney document to my attention via express service as soon as possible.

If you have any questions regarding this matter, please feel free to contact me at (612) 573-2006.

Regards,



Scott A. Lund

SAL:lj

Enclosures